



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,604	08/01/2000	MASOOD GARAH	ODS-23	8445
1473 7590 02/12/2007 FISH & NEAVE IP GROUP ROPES & GRAY LLP 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER JONES, SCOTT E	
			ART UNIT 3714	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
2 MONTHS		02/12/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/630,604
Filing Date: August 01, 2000
Appellant(s): GARAH ET AL.

MAILED
FEB 12 2007
Group 3700

Hong S. Lin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 7, 2005 appealing from the Office action mailed July 8, 2004.

Art Unit: 3714

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,004,211	Brenner et al.	10-1999
5,734,413	Lappington et al.	3-1998
5,999,808	LaDue	12-1999

Art Unit: 3714

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-86 and 91-133 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,004,211 to Brenner et al in view of Lappington et al. '413 (Lapp). In regard to claims 1 and 44, Brenner et al. teaches of an interactive off-track wagering (2:35-36) that is run over a computer based system to racing fans in their homes (5:61-64). Wagering is accomplished through network communication from a user terminal to a totalisator (7:35-43), and is communicated wirelessly from the user to the user terminal through any suitable user interface (7:21-34). While Brenner et al. does not specifically teach that the wireless remote control device has a screen with on-screen options, but he does teach that any suitable wireless user interface device can be used in conjunction with television sets for display (7:21-34). Lapp teaches of an interactive TV set-top system using a wireless remote handheld that is capable of displaying events for the purpose of switching between multiple interactive concurrent programs (Abstract). It is well known in that art that audio/video remote controllers are wireless multifunctional devices with user interface screens producing user selectable menus. Examples of such are devices specifically made as all-in-one audio/video remotes, or personal digital assistants

Art Unit: 3714

programmed with an extra function of control audio/video systems. With the remotes such as a personal digital assistant (PDA) it also would have been obvious to one skilled in the art at the time to display informational/wager choices on the PDA to allow the race to be displayed on a separate display continuously. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brenner et al. to use the wireless handheld taught by Lapp for the purposes as taught above in addition to reasons taught by Lapp such as view multiple concurrent events without losing scores. This would also allow one to place multiple concurrent bets on different races, releasing the constraints of betting only on a single game at any one time.

In regards to claims 2-6 and 45-49, Brenner et al. teaches that the race is a horse race (6:3) where a user can select a horse for a wager, a racetrack, a race, a wager type, and a wager amount (2:45-51).

In regards to claims 7-8 and 50-51, Brenner et al. teaches that totalisator is a computer system capable of handling user transactions, user accounts, crediting accounts when the wager is successful, and standard computer network communications (7:35-54).

In regards to claims 9 and 52, Brenner et al. teaches that the in-home equipment includes conventional television sets (7:26).

In regards to claims 10 and 53, Brenner et al. teaches the transmission of racing data via cable, satellite, or other mediums (6:55-61) and wagers transmitted over a network to computer equipment (7:35-54) where both types of information are received and sent to a user terminal. Brenner et al. does not teach that the user terminal is a set-top box, however it is obvious to one

Art Unit: 3714

skilled in the art that end user terminals for processing cable or satellite data for display on a television set can be set-top boxes.

In regards to claims 11-12 and 54-55, Brenner et al. teaches that the user terminal comprises personal computer equipment (7:55-67), and the computer equipment transmits the wager information to other computer equipment for processing (7:35-54).

In regards to claims 13-30 and 56-73, Brenner et al. teaches handicapping information and race results received by a user terminal (10:9-23). It was established earlier that wireless remote taught by Brenner et al. could comprise of a number of known remote control elements well known in the art such as a PDA therefore it would have been obvious to display handicap information and race results on the wireless remote device sent from the user terminal. In regard to the various claimed wireless remote devices, the handheld computer, electronic book, and web tablet it is well known in that art that these devices are function equivalents and it would have been obvious to one skilled in the art to substitute these devices for one another. It was also established earlier that the user terminal is a computer device (7:21-34) situated in a user's home (5:59-67) that is capable of network communications (7:35-54). It is well known in the art that a computer can function both as a set-top box as well as functions of personal computer making the devices functional equivalents. It would have been obvious to one skilled in the art at the time the invention was made to use various equivalent wireless remote devices in communication with a computer device as a user terminal for the purpose of receiving and displaying handicap and race results information to a user where the personal computer communication combinations would be better suited to a more technical/computer savvy demographic while the set-top box combinations to a less technical demographic.

Art Unit: 3714

In regards to claims 31-43 and 74-86, Brenner et al. teaches that each user can place a wager (7:35-41) from in home equipment (5:35-64) where the wagering system comprises of a large array of user terminals (7:10-11). This would suggest that users are placing wagers that are independent of one another and establishing individuality to the wagering system through the use of a personal identification code (8:41-50). Brenner et al. does not teach the use of a plurality of wireless devices communicating with the user terminal. However, it has long been considered to be within ordinary skill in the art to duplicate elements and their corresponding functions, especially in network communication where multiplicity of like devices is the norm, therefore, obvious to one skilled in the art at the time the invention was made to have a plurality of handheld devices place independent wagers with a user terminal. In regards to the choice of communication equipment, as established above, it would have been obvious to one skilled in the art to interchange functional equivalents of the handheld devices and the set-top or personal computer in their respective communication hierarchy.

In re claims 91-133, Brenner et al. in view of Lapp teach the claimed limitations as discussed above. In addition, as is well known in the art, communication exists with computer systems interpreting machine-readable instructions.

In re claims 142-144, Brenner et al. in view of Lapp teaches the claims limitations as discussed above, but does not disclose a set-top box as the sole communication interface between a handheld device and wagering servers. However, as is well known in the art, set-top devices can function both to transmit and receive information to/from remote servers. Lappington also teaches that a user can contact operations by using a wireless or wired medium (9:25-27) similar to how data is initially received. In view of Lappington's teaching of commensurate transmit and

Art Unit: 3714

receive communication mediums, it would not be beyond one of ordinary skill to modify Brenner in view of Lappington so that a single integrated device serves both purposes to reduce system complexity and costs.

Claims 89-90, and 134-141 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,004,211 to Brenner et al. in view of U.S. Patent No. 5,999,808 to LaDue. Brenner et al. teaches the above mentioned horse race wagering system, but does not disclose the use of a wireless application protocol for communication with a computer system. LaDue teaches the use of a wireless application protocol for use in wireless gaming and wagering (Abstract) for the purpose of operating seamlessly with existing wireless networks without need for further modification (2:26-29). LaDue also teaches the use of a handheld computer for communication with the wagering/gaming system with a built in screen capable of displaying users selectable menus (Fig 9). It would have been obvious to one skilled in the art at the time the invention was made to combine the wireless application protocol system for wagering by LaDue with the horse race wagering system as taught by Brenner et al. for the purpose of seamless operation with the existing wireless network infrastructure and so that wagering can take place anywhere legal including the race track or in a user's home.

In re claims 134-136, 138, and 140, Brenner et al. in view of LaDue teach a computer network system for wagering as discussed above. In addition, as is well known in the art, communication exists with computer systems interpreting machine-readable instructions.

In re claims 137, 139, and 141, Brenner et al. in view of LaDue teach a computer network system for wagering as discussed above. While not specifically disclosing computer equipment as part of a local area network, Brenner et al. shows in Fig. 1 shows the wager processing

Art Unit: 3714

equipment interconnected. Whether the equipment is connected in a local area or a wide area network, lacking criticality, would not serve to distinguish over prior art. The method of interconnection between equipment would not affect system functionality and could be made equivalent assuming adequate bandwidth.

(10) Response to Argument

A. Rejection of Claims 1-86 and 91-133 under 35 U.S.C. 103(a) as being unpatentable over Brenner et al. ("Brenner") U.S. 6,004,211 in view of Lappington et al. ("Lappington") U.S. 5,734,413.

1. Appellant alleges Brenner teaches away from a combination of Brenner and Lappington because Brenner teaches away from the transfer of the wagering screens of Brenner onto wireless handheld device 32 of Lappington. The Examiner respectfully disagrees with Appellant's statement. In no way does the claimed invention require "transferring wagering screens of Brenner onto wireless handheld device 32 of Lappington." Instead, claim 1 recites, "providing a user at the wireless portable computing device with on-screen options on the display of the wireless portable computing device that allow the user to create a wager for a given race to be run, wherein the on-screen options are based at least in part on information received over a wireless communications path between the wireless portable computing device and the in-home user equipment from the communications network;" (*Emphasis added*). The Examiner asserts there is nothing in the claim that requires "transferring wagering screens from the in-home user equipment to the wireless portable computing device." In fact, text or number selections on a wireless portable device would read on, "on-screen options are based at least in

Art Unit: 3714

part on information received over a wireless communications path between the wireless portable computing device and the in-home user equipment.

Brenner discloses,

User terminal 122, which is preferably microprocessor-based, supports software capable of coordinating the receipt and display of racing data and the placing of wagers electronically.

Preferably, user terminals 122 generate easy-to-read menus on displays 126, which may be, for example, conventional television sets. User terminal 122 executes instructions that enable terminal 122 to process the racing data received from distribution facility 120 and display the data on display 126 in a suitable format. The user can interact with user terminal 122 using any suitable user interface, such as a keyboard, pointing device, or voice-actuated controller. Preferably, the user interacts with user terminal 122 using an infrared or other suitable type of wireless remote control (Emphasis added) (Column 7, lines 21-34).

Brenner is silent to the wireless remote control having a display. However, Lappington teaches,

The present invention relates to an interactive system that includes an authoring system for creating sophisticated interactive programs, a data insertion system for inserting the interactive programs into the vertical blanking interval or other portion of a television, radio or other signal, means for transmitting the encoded television signal to remote sites, a settop device for stripping the interactive data from the television signal, and a handheld apparatus that presents the interactive program and allows the viewer to participate in the interactive program. (Emphasis added). (Column 5, lines 48-57).

Furthermore, Lappington teaches,

Art Unit: 3714

a script writer designs a script, and the script is compiled and broken down into a series of transactions which are sent to handheld 32. There are several types of scripts which can be designed separately or in combination, for example: standard mode, live events, polling, program or series, mini-games, or pay-per-play. A standard mode script can be either encoded onto a video tape or sent to data insertion 14 to be inserted in the VBI of a television signal in accord with the timing information programmed by the script writer. Live event scripts are to be used with live events, for example, sports, news and talk shows. With a live mode script, the script writer has selected text but does not insert timing information into the script. Rather, the script writer just sends a transaction at the appropriate time (Emphasis added) (Column 10, lines 27-40).

Thus, Lappington teaches of an interactive system that includes a signal means for transmitting an encoded television signal to a set top device and then from the set top device to a handheld apparatus (and vice-versa) (32-figures 11-12) that presents the interactive program (on display 398) and allows the viewer to participate in an interactive program. The interactive program may be a live event, such as a sporting event-horse racing. Therefore, the Examiner maintains the combination of Brenner and Lappington render the claimed invention obvious.

a. Handheld 32 of Lappington allegedly does not support graphics

As discussed above, "graphics" are not required on the wireless portable computing device. Text or numbers displayed on the wireless portable computing device display would suffice. Appellant admits,

Handheld 32 of Lappington is only configured to display transactions as text (see Lappington, column 11, lines 25-32 and column 20, lines 11 and 12). (See page 9, second paragraph of Appellant's Appeal Brief).

Art Unit: 3714

Thus, the Examiner maintains the combination of Brenner and Lappington render the claimed invention obvious.

b. LCD display 398 of handheld 32 of Lappington allegedly is too small to display information in the wagering screens of Brenner

Again, The Examiner notes there is nothing in the claims that require “transferring wagering screens from the in-home user equipment to the wireless portable computing device.” Therefore, the Examiner relies on the arguments provided above to refute this allegation.

2. The Examiner allegedly failed to provide a proper motivation for transferring the wagering interfaces of Brenner to handheld 32 of Lappington

Appellant again relies on the erroneous assumption that the combination of Brenner and Lappington would require “transferring wagering screens from the in-home user equipment to the wireless portable computing device” and that there is no motivation to do so. Therefore, the Examiner relies on the arguments provided above to refute this allegation.

Furthermore, the Examiner provides an adequate motivation to combine Brenner and Lappington in the rejections above. Additionally, in response to applicant's argument that there is no motivation to combine Brenner and Lappington, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Thus, the Examiner maintains the combination of Brenner and Lappington render the claimed invention obvious.

Art Unit: 3714

a. The examiner allegedly does not provide any objective evidence of motivation for providing racing videos and informational/wager choices on separate displays

Appellant again relies on the erroneous assumption that the combination of Brenner and Lappington would require “transferring wagering screens from the in-home user equipment to the wireless portable computing device” and that there is no motivation to do so. Therefore, the Examiner relies on the arguments provided above to refute this allegation. Please see the rejections above for the rationale used by the examiner to make the combination of Brenner and Lappington.

b. “View[ing] multiple concurrent events without losing scores” allegedly is not a proper motivation to transfer the wagering screens of Brenner to handheld

32 of Lappington

Appellant again relies on the erroneous assumption that the combination of Brenner and Lappington would require “transferring wagering screens from the in-home user equipment to the wireless portable computing device” and that there is no motivation to do so. Therefore, the Examiner relies on the arguments provided above to refute this allegation.

Furthermore, the Examiner provides an adequate motivation to combine Brenner and Lappington in the rejections above. Additionally, in response to applicant's argument that there is no motivation to combine Brenner and Lappington, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Art Unit: 3714

c. The Examiner's motivation allegedly would not lead one to transfer the wagering screens of Brenner on handheld 32 of Lappington

Appellant alleges,

even if "view[ing] concurrent events without losing scores" is a proper motivation, it would not lead one skilled in the art to provide the wagering interfaces of Brenner on handheld 32 of Lappington.

However, Appellant again relies on the erroneous assumption that the combination of Brenner and Lappington would require "transferring wagering screens from the in-home user equipment to the wireless portable computing device" and that there is no motivation to do so. Thus, the Examiner relies on the arguments provided above to refute this allegation.

B. Rejection of Claims 142-144 under 35 U.S.C. 103(a) as being unpatentable over Brenner et al. ("Brenner") U.S. 6,004,211 in view of Lappington et al. ("Lappington") U.S. 5,734,413.

Appellant relies on the same arguments provided above in item A. Similarly, the examiner relies on the same arguments presented above to refute the allegations.

C. Rejection of Claims 89-90 and 134-141 under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,004,211 to Brenner in view of U.S. 5,999,808 LaDue.

Appellant alleges the combination of Brenner and LaDue fails to show or suggest,

allowing the user to transmit the wager from the wireless user equipment to a communication network via communications equipment at a racetrack that communicates wirelessly with the wireless user equipment" (emphasis added), as required by independent claims 89, 90, and 135. (Page 18, second paragraph of Appellant's Appeal Brief).

Art Unit: 3714

Brenner was discussed as teaching wireless wagering to and from a user terminal through any suitable user interface. Brenner also teaches information delivery can be accomplished through broadcast or satellite systems (Column 7, lines 4-9) and that transactions can be accomplished through any suitable, conventional, communication circuitry (Column 8, lines 30-40). LaDue was used to show that using a wireless application protocol for wireless wagering is known and can be integrated into existing wireless networks without requiring additional network build-outs. LaDue also clearly shows that user equipment communicates wirelessly to place wagers (Fig. 9 and 9B). With this information Examiner believes that there are no gaps in features taught by Brenner in view of LaDue to meet Applicant's claims and the rejection was proper.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Scott E. Jones

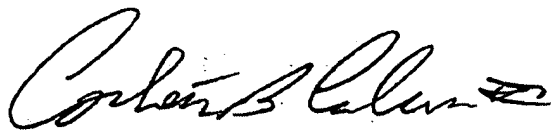
Art Unit 3714, Primary Examiner



SCOTT JONES
PRIMARY EXAMINER

Conferees:

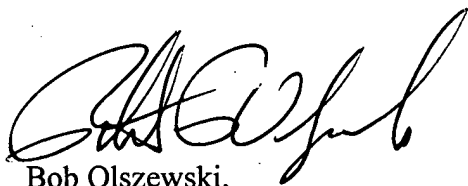
Art Unit: 3714

A handwritten signature in black ink, appearing to read "Corbett B. Coburn" with a stylized flourish at the end.

**CORBETT B. COBURN
PRIMARY EXAMINER**

Corbett Coburn

Art Unit 3714, Primary Examiner

A handwritten signature in black ink, appearing to read "Bob Olszewski" with a stylized flourish at the end.

Bob Olszewski,

Art Unit 3714, SPE